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H. STUART CUNNINGHAM

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

BALLY MANUFACTURING CORPORATION,)

Plaintiff,)

v.)

CIVIL ACTION NO. 78 C 2246

D. GOTTLIEB & CO.,)

WILLIAMS ELECTRONICS, INC.,)

and)

ROCKWELL INTERNATIONAL CORPORATION,)

Defendants.)

and)

BALLY MANUFACTURING CORPORATION,)

Plaintiff,)

v.)

CIVIL ACTION NO. 79 C 713

GAME PLAN, INCORPORATED and)

ASTRO GAMES, INC.,)

Defendants.)

PLAINTIFF'S SUPPLEMENTAL MEMORANDUM IN
OPPOSITION TO ROCKWELL'S MOTION TO DISMISS

Plaintiff submits this Supplemental Memorandum in Opposition to Rockwell's Motion to Dismiss to deal with two matters which have arisen subsequent to the filing of plaintiff's original memorandum in opposition to this motion.

First, the Court's attention is directed to a recent decision of the U.S. Court of Customs and Patent Appeals, In re James R. Diehr, II, et al., Appeal No.

79-527, decided August 9, 1979, which is directly applicable to one of the primary issues raised by Rockwell and which came to plaintiff's attention only after Rockwell's reply brief was received. A copy of the opinion in this case is attached hereto.

Second, Rockwell in its reply memorandum, for the first time, takes a position with respect to Brunswick and Rockwell's relationship to Brunswick regarding micro-computer pinball games, which is inconsistent with the position that Rockwell has taken in the Patent and Trademark Office in its protest to the reissue of the patent in suit.

With respect to the first matter, the Court of Customs and Patent Appeals, in In re Diehr, explained the holdings of the cases cited by Rockwell and came to a different conclusion than Rockwell as to what these cases held. In particular, Rockwell erroneously relies on Parker v. Flook 437 U.S. 584 (1978) and Gottschalk v. Benson 409 U.S. 63 (1972) for the proposition that a computer program is outside the scope of patentable invention under 35 U.S.C. §101, and, therefore, the Rockwell pinball controller (as supplied to defendant Gottlieb and possibly others, including Brunswick) which Rockwell contends differs from its general purpose controller only by programming, cannot be a material part of any invention (including the invention of the patent in suit) as required by the contributory

infringement statute, 35 U.S.C. §271(c). This position, while untenable by itself because it is contrary to the facts as shown by the Footh deposition, is also based on a false premise as a matter of law as shown by the recent Diehr case.

In Diehr, the Court when interpreting whether certain process claims were directed to proper patentable subject matter under 35 U.S.C. §101 held, "the fact that it may be said that an invention is drawn to a computer program or involves a computer is an observation which does nothing in aiding determination of compliance with §101." (p. 8) Upon analyzing Flook, the Court in Diehr further pointed out that "From the [United States Supreme] Court's holding [in Flook] itself, as well as from its discussion of the applicable legal principles, it is clear that the claims were held to be fatally deficient under §101, not because a computer program was being claimed, but because a mathematical formula or algorithm per se was being claimed." (pp. 10-11)

Under Diehr then, the mere fact that a claimed invention contains a computer or a computer program does not make it improper subject matter under 35 U.S.C. §101. This being true, the entire Rockwell controller as sold to Gottlieb which contains a permanently programmed computer so that it can only be used in solid-state pinball machines, and which is the very heart and essence of the infringing

Gottlieb machines, is without question a material part of the invention which is not suitable for substantial noninfringing uses. Therefore, Rockwell, by the sale of that controller to Gottlieb for use in its infringing solid-state pinball machines is clearly guilty of contributory infringement under 35 U.S.C. §271(c).

The erroneous factual premise relied on by Rockwell is that the controller supplied to Gottlieb differs only from the general purpose controller by programming. As shown by the Affidavit of Zane A. Sandusky, submitted by Rockwell in support of its motion to dismiss, in Paragraph (6) thereof, the general purpose controller and the Gottlieb pinball control are stated to use completely different microcomputer systems. The Gottlieb pinball controller uses a PPS-4 system while the general purpose controller uses the R-6500 system. Each of these systems constitutes a different family of "building blocks" according to Rockwell's employee, John Footh (Footh Dep., p. 21, attached hereto).

As noted on page 10 of Plaintiff's original memorandum in opposition to this motion, the Rockwell parts A-1752 and A-1753, while relating to the program of the controller, are not standard or of general purpose but "the codes in them make them a unique part number -- only usable in this [pinball machine] application." (Footh dep. p. 188,

attached to plaintiff's original memorandum in opposition to the motion).

Furthermore, the patent in suit does not claim a "mathematical formula or algorithm per se" and therefore clearly does not come under the rule of the Flook or Benson cases with respect to nonpatentable subject matter. Thus, the Gottlieb pinball controller can be, and is, a material part of the invention of the patent even if Rockwell's premise were correct that it differs from the general purpose controller only by programming.

With respect to the second matter, Rockwell, in its reply to plaintiff's original memorandum in opposition to this motion, contends that sales of computer pinball controllers to others than Gottlieb are not relevant to the issues of the present lawsuit. In support of this contention, Rockwell states that Brunswick is neither a party to the present litigation nor has it been accused as a direct infringer of the patent in suit, and that, without an allegation that Brunswick is a direct infringer, there can be no contributory infringement or inducement.

On the other hand, Rockwell, in its protest filed in the Patent and Trademark Office on September 14, 1979, states in a footnote on page 2 (copy attached) that "protester is presently investigating the developments at Brunswick Corporation (Skokie, Ill.), Sega Enterprises, Ltd. (Tokyo, Japan) and United Games, Inc. (Portland, Oregon) all

of whom had developed early micro-computer controlled pinball games." In view of the fact that Rockwell, itself, says that it is investigating the early developments at Brunswick Corporation relating to pinball games as a defense to the patent in suit, Rockwell must recognize that the pinball game resulting from the Brunswick development could well employ the invention of the patent and constitute a direct infringement if it were later than the date of the invention of the patent in suit. Thus, Rockwell not only admits the relevancy of the Brunswick activities in the Patent and Trademark Office but actually hopes to rely on those activities in connection with its submissions against the patent in those proceedings.

Rockwell's involvement with Brunswick was indicated by John Footh, Rockwell's employee, who testified that there was development work done by Rockwell with respect to Brunswick, and also with respect to Sega and perhaps others. However, all discovery regarding Brunswick was blocked by Rockwell's counsel even though it certainly is relevant to the question of Rockwell's activities and conduct which would constitute evidence of inducement to infringe the patent in suit now admitted by Rockwell in its reply memorandum to have been known by it prior to the filing of the amended complaint.

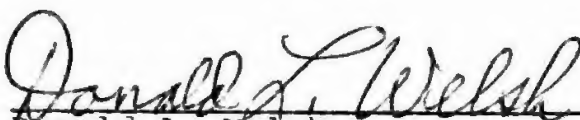
Unlike the situations discussed in Rockwell's reply memorandum wherein a single manufacturer induces the

infringement by a multitude of individual customers who cannot be sued with practicality, in the instant case it is Rockwell who is the source of the material part of the patented invention which is being sold to pinball manufacturers who did then become the direct infringers. Thus, in the present circumstances it is more practical to sue the supplier and stop the further inducement by others as direct infringers than to bring individual actions against all of Rockwell's customers for such systems. Whether or not direct infringers have been charged with the direct infringement is not material to whether or not Rockwell is inducing infringement so long as there is actually direct infringement. Thus, Rockwell can be found guilty of inducing infringement by a direct infringer who is not even a party to the suit.

Even if Rockwell is correct in its statement of the title of the earlier version of the bill that became 35 U.S.C. §271 relative to protection of patent rights wherein enforcement against direct infringers is impractical, the Congressional intent of providing a practical remedy is met here by maintaining the action against Rockwell International, the source of the electronic systems which formed the heart of the invention. However, the fact that this title was dropped when the section was enacted tends to indicate that the restrictions imposed by such a title were

not intended to apply and that both parties, the direct and contributory infringer or inducer could be sued as joint tort feasers.

For the reasons set forth above and in plaintiff's original memorandum opposing Rockwell's motion to dismiss, it is submitted that the motion should be denied.

By 
Donald L. Welsh
A. Sidney Katz
Jerold B. Schnayer
Fitch, Even & Tabin
135 South LaSalle Street
Chicago, Illinois 60603
(312) 372-7842

Attorneys for Plaintiff,
Bally Manufacturing
Corporation

October 17, 1979

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS EASTERN DIVISION

BALLY MANUFACTURING
CORPORATION,

PLAINTIFF,

VS.

D. GOTTLIEB & CO., AND
WILLIAMS ELECTRONICS, INC.,
AND ROCKWELL INTERNATIONAL
CORPORATION,

DEFENDANTS.

NO. CIVIL ACTION
78 C-2246

DEPOSITION OF JOHN W. FOOTH, TAKEN ON BEHALF OF
PLAINTIFF, AT 3370 EAST MIRALOMA AVENUE, ANAHEIM, CALIFORNIA,
COMMENCING AT 1:00 P.M., WEDNESDAY, AUGUST 8, 1978, BEFORE
THERESA DE LAO, CSR NO. 3983, A NOTARY PUBLIC IN AND FOR THE
STATE OF CALIFORNIA, COUNTY OF ORANGE, PURSUANT TO NOTICE.

APPEARANCES:

FOR PLAINTIFF:

FITCH, EVEN & TABIN
ATTORNEYS AT LAW
BY: A. SIDNEY KATZ
DONALD L. WELSH
JEROLD B. SCHNAYER
135 SOUTH LA SALLE STREET
CHICAGO, ILLINOIS 60603

FOR DEFENDANT
ROCKWELL INTERNATIONAL,
D. GOTTLIEB & CO.:

ARNOLD, WHITE & DURKEE
ATTORNEYS AT LAW
BY: WAYNE HARDING
2100 TRANSCO TOWER
HOUSTON, TEXAS 77056

1 BY MR. KATZ:

2 Q WHAT IS THAT UNDERSTANDING?

3 A IT'S WHAT I WOULD CALL A CPU DEVICE.

4 Q WHAT DO YOU MEAN BY CPU DEVICE?

5 A CENTRAL PROCESSING UNIT.

6 Q DOES THE R-6500 CONTAIN A CPU DEVICE?

7 A YES.

8 Q IS THERE SOME DESIGNATION FOR IT?

9 A THERE ARE SEVERAL. I DON'T RECALL THE PART
10 NUMBERS.

11 Q IS THERE ANY RELATIONSHIP BETWEEN THE R-6500 AND
12 THE PPS-4?

13 A YES.

14 Q WHAT IS THAT RELATIONSHIP?

15 A EACH OF THEM IS A FAMILY OF DEVICES THAT CAN
16 PERFORM MICROCOMPUTER-TYPE OPERATIONS. IT'S A FAMILY OF
17 BUILDING BLOCKS.

18 Q SO THERE'S A PPS-4 FAMILY OF BUILDING BLOCKS, AND
19 THERE'S AN R-6500 FAMILY OF BUILDING BLOCKS; IS THAT CORRECT?

20 A YES.

21 Q IS THERE AN ORDER IN TIME IN WHICH EACH ONE OF
22 THEM CAME OUT?

23 A YES.

24 Q WHICH WAS FIRST?

25 A THE PPS-4.

26 Q THEN THE R-6500 WAS A LATER FAMILY OF BUILDING
27 BLOCKS WHICH BECAME AVAILABLE FROM ROCKWELL INTERNATIONAL?

28 A YES.

561 J 1313

OF

1/ This application is a continuation of application serial No. 472,595, filed May 23, 1974, now abandoned, which is a continuation-in-part of application serial No. 401,127, filed September 26, 1973, now abandoned.

The Invention

Appellants claim a method for operating molding presses used in the manufacture of rubber articles. More specifically, appellants' method produces molded articles which are properly cured, in that their method insures that the articles remain in the press for a period of time sufficient to insure that they are not overprocessed or underprocessed.

According to appellants' specification, achieving a perfect cure depends upon several factors, including the thickness of the article to be molded, the temperature of the molding press, and the amount of time that the article is allowed to remain in the press. These factors are related by the Arrhenius equation,^{2/} which appellants acknowledge has always been used to calculate the cure time in rubber molding processes.

From a reading of appellants' specification and their brief before this court, it appears that they characterize their

2/ The Arrhenius equation is expressed as follows:

$$\ln v = C Z + x$$

wherein $\ln v$ is the natural logarithm of v , the total required cure time; C is the activation constant, a unique figure for each batch of each compound being molded, determined in accordance with rheometer measurements of each batch; Z is the temperature in the mold; and x is a constant dependent on the geometry of the particular mold in the press.

A rheometer is an instrument to measure flow of viscous substances.

contribution to the art as residing in the step of repeatedly or constantly measuring the actual temperature in the mold.

These temperature measurements are then used to calculate the cure time by repeatedly using the Arrhenius equation to arrive at the actual cure time, rather than by the conventional method which uses a single calculation using that equation based upon the temperature nominally set by a thermostat which controls the heater in the molding press. The conventional method is inherently inaccurate because the temperature value used in the equation is rarely, if ever, the true temperature in the mold environment.

Claim 1 is representative and reads:

1. A method of operating a rubber-molding press for precision molded compounds with the aid of a digital computer, comprising:

providing said computer with a data base for said press including at least,

natural logarithm conversion data (\ln),

the activation energy constant (C) unique to each batch of said compound being molded, and

a constant (x) dependent upon the geometry of the particular mold of the press,

initiating an interval timer in said computer upon the closure of the press for monitoring the elapsed time of said closure,

constantly determining the temperature (Z) of the mold at a location closely adjacent to the mold cavity in the press during molding,

constantly providing the computer with the temperature (Z),

repetitively calculating in the computer, at frequent intervals during each cure, the Arrhenius equation for reaction time during the cure, which is

$$\ln v = C Z + x$$

where v is the total required cure time,

repetitively comparing in the computer at said frequent intervals during the cure each said calculation of the total required cure time calculated with the Arrhenius equation and said elapsed time, and

opening the press automatically when a said comparison indicates equivalence.

The other claims are similar. Claim 11 does not recite the use of a computer to do the calculating, but, as we shall explain, we find this fact to be of no moment.

The Rejection

The examiner rejected the claims because he believed that the only non-conventional claim steps "define a computer program for taking repeated temperature measurements from the mold and calculating cure time in response to said measurement data." On this basis, he decided that appellants were claiming a

computer program, "subject matter [to] which the Supreme Court has declined to extend patent protection absent a considered action by Congress."

The board agreed with the examiner. It dismissed appellants' argument that no computer program was disclosed in the specification, citing an admission to the contrary made by appellants during prosecution.^{3/} The board was aware of the then newly announced Supreme Court decision in Parker v.

3/ Appellants have consistently argued that they have not disclosed a computer program in their specification, but in a preliminary amendment, filed August 6, 1975, with their application, they stated:

The original affidavit by applicants under Rule 132 disclosed that the flow sheet [Figs. 3A and 3B of the specification] is itself basically a program and that the only difference between the flow sheet as a program and the form taken by the program when it gets into the computer is translation into a suitable computer language * * *.

An affidavit of the applicants, dated July 18, 1975, states:

THAT the program shown in the flow sheets, Figs. 3A and Fig. 3B, is actually a "program" so far as the programmer is concerned and that to apply the "program" * * * to a computer merely involves translation of the symbolic flow sheet into [a suitable computer language].

Thus, by their own admission, it is clear that appellants have disclosed a computer program. However, this fact, by itself, has no significance in the §101 inquiry, as we shall explain, infra.

Flook, 437 U.S. 584, 198 USPQ 193 (1978) (hereinafter Flook), and made use of it in support of its decision to affirm the rejection.

The board, in its examination of claim 1, perceived the only "non-programming" step to be "constantly determining the temperature (Z) of the mold," and stated that according to appellants' specification, in "Background of the Invention," it was old in the art. The board analyzed the other steps recited in claim 1 as being directed to gathering data for use in the recited formula or as "post solution activity," which, according to Flook, would not render the claims statutory. The board concluded that appellants' system involves an algorithm solving a mathematical problem in the sense involved in Flook.

After similarly analyzing the remainder of the appealed claims, the board concluded as follows:

It is our view that the only difference between the conventional methods of operating a molding press and that claimed in appellants' application rests in those steps of the claims which relate to the calculation incident to the solution of the mathematical problem or formula used to control the mold heater and the automatic opening of the press.

We think that appellants' contribution, regardless of claim format, is a computer program of the character which the USSC has indicated, in both Flook and Benson, [4/] is outside the bounds of 35 USC 101. [Emphasis ours.]

4/ Gottschalk v. Benson, 409 U.S. 63, 175 USPQ 673 (1972).

Appellants' Arguments

Appellants argue that they have claimed a process which is basically chemical and physical in nature, not a computer program or the type of mathematical algorithm involved in Flook. They do, however, as they must, acknowledge that calculations according to a recited formula are explicitly involved in the claimed process.

They strenuously take issue with the factual conclusion made by both the examiner and the board that their step of continuously measuring the temperature in the mold cavity is old in the art. They attribute this error to a misreading of their specification and assert that they are the first to employ this step in the molding process.

Appellants also say that the PTO has erred by dissecting their claims into what the PTO considers to be novel and non-novel elements in order to wrongfully conclude that they are claiming a computer program. They assert that the Supreme Court has never placed a blanket prohibition on the patenting of computer programs and, consequently, that the labeling of an invention as a computer program is not a proper method by which to reject a claim under §101.

Finally, they argue that there is no prohibition on the patenting of all inventions which involve the use of a

computer and that their invention, while it does involve the use of a mathematical formula, does not claim the mathematical formula in a nonstatutory manner. They say that their claims, as entires, do not define methods of solving a mathematical problem and are statutory under this court's test applied in In re Johnson, 589 F.2d 1070, 200 USPQ 199 (CCPA 1978).

OPINION

A claim drawn to a process or method does not depend for its validity under 35 USC 101 on whether a computer is involved. If the claim is drawn to subject matter, which is otherwise statutory, it does not become nonstatutory merely because a computer is involved in its execution. Thus, the fact that it may be said that an invention is drawn to a computer program or involves a computer is an observation which does nothing to aid in the determination of compliance with §101. In re Gelnovatch, 595 F.2d 32, 36-37, 201 USPQ 136, 141 (CCPA 1979); In re Johnson, 589 F.2d 1070, 1081, 200 USPQ 199, 210-11 (CCPA 1978); In re Chatfield, 545 F.2d 152, 155, 191 USPQ 730, 733 (CCPA 1976). Therefore, any rejection which is based solely on the determination that a computer or computer program is involved is insupportable because it is overly broad and must be reversed as being without basis in the law.

The Supreme Court, in the two instances in which it has addressed itself to the §101 issue in cases where computer-related inventions are involved, has not said anything to the contrary. Our view is not in any way inconsistent with these precedents.

In Gottschalk v. Benson, supra n. 4 (hereinafter Benson), the Court addressed a claimed method for converting binary coded decimal (BCD) numbers to equivalent pure binary numbers. The Court observed that the claims were "not limited to any particular art or technology, to any particular apparatus or machinery, or to any particular end use. They purported to cover any use of the claimed method in a general-purpose digital computer of any type." 409 U.S. at 64, 175 USPQ at 674. The Court determined that the claimed method was a mathematical algorithm, i.e., a "procedure for solving a given type of mathematical problem," and further, that "The mathematical procedures can be carried out in existing computers long in use, no new machinery being necessary. And, as noted, they can also be performed without a computer." Id. at 65, 67, 175 USPQ at 674, 675.

The Court reviewed long-standing precedent to the effect that while an abstract principle or idea, or a scientific

truth, or its equivalent mathematical expression is non-statutory, an invention created from the application of such a truth or useful structure created therefrom is statutory.

The Court then proceeded to hold Benson's invention to be nonstatutory with the following statements (Id. at 71-72, 175 USPQ at 676, emphasis ours):

We do not hold that no process patent could ever qualify if it did not meet the requirements of our prior precedents. It is said that the decision precludes a patent for any program servicing a computer. We do not so hold. It is said that we have before us a program for a digital computer but extend our holding to programs for analog computers. We have, however, made clear from the start that we deal with a program only for digital computers. It is said we freeze process patents to old technologies, leaving no room for the revelations of the new, onrushing technology. Such is not our purpose. What we come down to in a nutshell is the following.

It is conceded that one may not patent an idea. But in practical effect that would be the result if the formula for converting BCD numerals to pure binary numerals were patented in this case. The mathematical formula involved here has no substantial practical application except in connection with a digital computer, which means that if the judgment below is affirmed, the patent would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself.

From the Court's holding itself, as well as from its discussion of the applicable legal principles, it is clear that the claims were held to be fatally deficient under §101, not

because a computer program was being claimed, but because a mathematical formula or algorithm per se was being claimed. Important to the Court's reasoning was the fact that the formula involved dealt with the binary radix, or base two number system. The only practical and significant application of the binary system in the real world is in connection with digital computers, which operate in the binary system -- a system easily represented electrically by the "on" and "off" or conducting and nonconducting states of the circuit elements comprising the computer. Seen in this light, it is apparent that the claim would, in effect, dominate all practical and significant uses of the formula. Thus, the Court viewed the claim as directed to the scientific truth itself, rather than to an application of, or structure created with the aid of, the scientific truth. This belies any notion that the claims were held to be nonstatutory because drawn to a computer program per se.

Parker v. Flook, supra, presented the Supreme Court with a similar situation. The claims were drawn to a method for updating an alarm limit used in petroleum refining processes. The Court determined that the claims were essentially directed to the use of a new mathematical formula

in the conventional process of updating alarm limits. According to the majority, "Respondent's application [sic, claimed invention] simply provides a new and presumably better method for calculating alarm limit values." 437 U.S. at 594-95, 198 USPQ at 199 (emphasis ours). As in Benson, the Court in Flook was simply saying that the claims were an attempt to patent the scientific truth itself, rather than an application of the truth or a structure created by its use. "[I]f a claim is directed essentially to a method of calculating, using a mathematical formula, even if the solution is for a specific purpose, the claimed method is nonstatutory." 437 U.S. at 595, 198 USPQ at 199, quoting In re Richman, 563 F.2d 1026, 1030, 195 USPQ 340, 343 (CCPA 1977).

The Court's holding in Flook was "very simply" stated: "[O]ur holding today is that a claim for an improved method of calculation, even when tied to a specific end use, is unpatentable subject matter under §101." Id. n. 18. (Emphasis ours.) As in Benson, this holding has nothing to do with computers or computer programs per se.

This, as we perceive it, is the direction which has been given us by the Supreme Court. Until the Court directs us otherwise, we continue to disagree with the notion that a claim

may be rejected as nonstatutory merely because it involves a computer program or is computer-related. As far as we are concerned, claims may be rejected under §101 because they attempt to embrace only a mathematical formula, mathematical algorithm, or method of calculation, but not merely because they define inventions having something to do with a computer.

In view of the foregoing, to the extent that the examiner's position is based upon the mere alleged presence of a computer program in appellants' claims, it is without basis in the law and cannot be sustained. The board, however, in addition to stating the inadequate reason that a computer program is involved, analyzed the claims to determine what steps in the process were old or conventional and apparently ignored such steps, confining its consideration to the nature of what it deemed to be "appellants' contribution." It then found that contribution to be a "computer program" relating to a calculation incident to the solution of a mathematical problem or formula used to control the opening of the press, and, for that reason, held the claims to be drawn to nonstatutory subject matter under Flook and Benson. We wish to make clear that this analysis is the only basis upon which we are reviewing the rejection, and that, but for

this reasoning, we would be constrained to summarily reverse or remand this case to the board for an adequate analysis. See In re Phillips, 593 F.2d 1021, 201 USPQ 257 (CCPA 1979).

Appellants and the PTO have locked horns over whether the step of continually measuring the temperature in the mold cavity is old in the art. While we are inclined to agree with appellants that the record is devoid of any evidence that this step was ever performed by persons other than appellants,^{5/} we fail to see what relevance this issue has to the §101 inquiry. Considerations of novelty and obviousness have no bearing on compliance with §101. In re Bergy, 596 F.2d 952, 960-61, 962-63, 201 USPQ 352, 361, 362 (CCPA 1979); Nickola v. Peterson, 580 F.2d 898, 906-907, 198 USPQ 385, 395-96 (6th Cir. 1978). Thus, the fact that certain limitations in a claim may be novel and certain others

5/ The fact that a thermostat has been used to control the mold heater does not mean that the mold temperature has been continually measured. A thermostat reacts to only one temperature -- the one to which it has been set. It is incapable of discretely recognizing the existence of any other definite temperature, and, hence, is incapable of continually measuring the temperature of the environment in which it has been placed; it merely knows whether the actual temperature is above or below the set point. This can hardly be called temperature measurement.

may be old is irrelevant to the outcome of this case.^{6/} The focus of the inquiry should be whether the claim, as a whole, is directed essentially to a method of calculation or mathematical formula. No one step or subgroup of steps determines whether the entire claim defines statutory subject matter. Flook, 437 U.S. at 594 n. 16, 198 USPQ at 199 n. 16; In re Chatfield, 545 F.2d at 158, 191 USPQ at 738. We are concerned only with what entire claims define and with whether that falls within §101.

We turn now to a consideration of the claims on appeal. Appellants attach significance to the fact that claim 11, unlike the remaining claims, does not anywhere recite a computer. In light of our foregoing discussion regarding §101, we do not find either the presence or absence of computer-related recitations in a claim to be of any significance. If the claim is drawn to a mathematical algorithm, formula, or method of calculation, it is nonstatutory whether it

6/ Although in Flook the Supreme Court assumed the equation of the claim to be old in the art even though it was not, the holding of that case does not depend on that mode of analysis. Since Flook's claims were held to be directed to methods of calculation, they were nonstatutory regardless of whether the equation was new or old. While the Supreme Court in that case may have found that analysis a convenient vehicle to highlight the fact that Flook's actual contribution to the useful arts was his new formula, we do not believe the Court meant to establish that analysis as a general test in determining compliance with §101, especially when indiscriminately applied to claim limitations generally.

recites that a computer, an abacus, or a pencil and paper are used to make the calculations. The statutory nature of a process or method does not depend, under §101, on the means used to carry it out. In re Gelnovatch, supra, In re Johnson, supra.

Since the claims before us directly recite a mathematical formula, namely, the Arrhenius equation, they must be subjected to further scrutiny. The mere presence of a mathematical formula in a claim is not a prima facie ground for holding that claim to be nonstatutory, Flook, 437 U. S. at 590, 198 USPQ at 197; In re Johnson, 589 F.2d at 1076 n. 5, 200 USPQ at 206 n. 5, but, for the claim to be statutory, there must be some substance to it other than the recitation and solution of the equation or formula. The formula, as an embodiment of a scientific principle, must be applied in some useful manner in a method or process, see, e.g., Tilghman v. Proctor, 102 U.S. 707 (1880) (scientific fact or principle, of which a mathematical formula is one example, used in a chemical process), or be embodied in the design of some useful structure, machine or apparatus, see, e.g., Eibel Process Co. v. Minnesota and Ontario Paper Co., 261 U.S. 45 (1923) (law of gravity, expressible in mathematical terms, used in design of a paper-making machine).

This court has formulated a two-step test to determine compliance with §101 of a claim involving mathematics. In re Freeman, 573 F.2d 1237, 1245, 197 USPQ 464, 471 (CCPA 1978). Since, under the first step of the test, the determination that the claim involves mathematical calculations has already been made, we proceed to the second step of the test to determine "whether the claim merely recites a mathematical formula or a method of calculation as in Benson and Flook." In re Johnson, 589 F.2d at 1077, 200 USPQ at 207. We conclude that it does not.

Each of appellants' claims, as a whole, recites a process or method for molding rubber articles. They are an improvement over prior processes in that appellants provide for opening the mold at precisely the correct time rather than at a time which has been determined by approximation or guesswork. It is this feature of the process that involves the Arrhenius equation. The recitation of the equation is not separable from the process in which it is used; it is intimately involved in the process, but the claims are not to the equation. We find these claims to be directly comparable to those involved in Tilghman v. Proctor, supra, and Eibel Process Co. v. Minnesota and Ontario Paper Co., supra, in that they

involve the employment of a scientific truth to a new and useful end without attempting to control the use of the truth itself.

As Mr. Justice Stone, writing for the Court in Mackay Radio and Telegraph Co. v. Radio Corporation of America, 306 U.S. 86 (1939), stated (306 U.S. at 94):

While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.

Though he spoke of "structure" the same is true of a process and the reasoning applies with equal force. The claims here at issue are not, as the PTO asserts, directed to an improved method of calculation for the cure time of rubber articles; such a conclusion is only made possible by ignoring the fact that a molding press is recited and operates as the heart of the process. The PTO has separated the claim into old and new elements, ignoring the presence of the old elements in its analysis. Such reasoning is impermissible. The novelty or otherwise of any element or even of all the elements or steps, or of the combination has no bearing on whether the process is encompassed by §101.

The claims here on appeal are fundamentally different from the claims involved in Flook. They recite a process involving the manipulation of apparatus resulting in the

chemical and physical change of starting material, the time that the mold remains closed being controlled by a series of calculations using a recited formula. See In re Deutsch, 553 F.2d 689, 193 USPQ 645 (CCPA 1977) (claimed methods of operating an entire manufacturing plant system using particular algorithms); In re Chatfield, supra (claimed methods of operating machines in a more efficient manner using particular algorithms). It would be a gross distortion to say that the claims on appeal are directed essentially to calculations. In Flook, by contrast, the claims recite nothing but the calculation, coupled with the post-solution activity consisting only of updating an alarm limit to the newly-calculated value which is merely a new number. Here, the calculation is intimately entwined with the rubber molding process recited. Therefore appellants are not claiming a process for merely generating a new number by a calculation.

Stated as a general proposition, "regardless of claim format" as the board said, one would hardly question that a rubber-molding process falls within the §101 categories of possibly patentable subject matter, and that is what is claimed. We see no reason why particularizing in claims a more precise way of timing the molding cycle should remove them from the

"process" category of §101. The board erred in ignoring all of the old or conventional steps in the claims. Novelty considerations have no bearing on whether claims define statutory subject matter under §101.


The decision of the board is reversed.

REVERSED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)	Reissue of U.S. 4,093,232,
DAVID J. NUTTING, et al.)	Issued June 6, 1978
Serial No.: 936,784)	Group Art Unit: 334
Filing Date: August 25, 1978)	Examiner: Hum
For: PLAYER OPERATED GAME)	<u>REISSUE LITIGATION</u>
APPARATUS)	

37 C.F.R. 1.291 PROTEST BY
ROCKWELL INTERNATIONAL CORPORATION



Rockwell International Corporation ("Rockwell") believes the subject matter of U.S. Patent No. 4,093,232 (the "Patent") to be unpatentable over prior art not of record in the original prosecution or in these reissue proceedings.

Rockwell is a supplier of microprocessor chip sets to D. Gottlieb & Co. ("Gottlieb") which in turn incorporates those chip sets in pinball games. Because of its role as a supplier to Gottlieb, Rockwell has been added as a party in Bally Mfg. Corp. v. D. Gottlieb & Co., Williams Electronics, Inc. and Rockwell International Corp., Civil Action No. 78-C-2246 in the U.S. District Court for the Northern District of Illinois. In that litigation, Rockwell has been charged with contributory infringement and inducing infringement because it sells its microprocessor chip set to Gottlieb.

Hence, Rockwell has a real and direct interest in these reissue proceedings.

I. SUMMARY

1. The patented subject matter is obvious under 35 U.S.C. 103 in view of references not of record during prosecution.

a. It was obvious to apply a general purpose microcomputer-type controller as a controller in a pinball game (as taught by Intel Corporation by March, 1974), in the conventional and recommended manner (as taught by Intel Corporation by 1972), i.e., scanning an input matrix of switches for status information, storing the status information, and in response to the stored status information controlling an output display matrix. Intel taught that both the input switch matrix and the display matrix could use a multiplexing technique employing the same strobe signals for scanning the input switch matrix and the output display matrix.

b. It was obvious to do what at least three¹ separate entities other than Nutting et al. did prior to May, 1975: replace conventional hard-wired relay logic in standard pinball games with a controller using one of the general purpose microcomputer chip-sets which were just becoming commercially available in production

1. Atari, Inc.; Ramtek, Inc.; and Bally Mfg. Co., the Re-issue Applicant itself. Protestor is presently investigating the developments at Brunswick Corporation (Skokie, Ill.), Sega Enterprises, Ltd. (Tokyo, Japan), and United Games, Inc. (Portland, Oregon) all of whom had developed early microcomputer controlled pinball games.